

REMARKS

This paper is in response to the Office Action dated April 23, 2003. This amendment is timely filed as it is accompanied by a petition for a one month extension of time and the requisite fees therefore, extending the response date to August 25, 2003 (August 23, 2003 being a Saturday).

A. STATUS OF THE CLAIMS

By this amendment, claims 1-37 have been canceled and claims 38-65 have been added. Thus, claims 38-65 are presently pending.

B. RESPONSE TO THE OFFICE ACTION

The discussion is based on the following claim construction:

Although the patent application describes various embodiments and makes various statements regarding the "invention," it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification of a patent application into the claims. It should also be recognized that the term "invention" may be used to mean various different things.¹ For example, the term "invention" may be used to refer to the

¹ This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term "invention" is defined as follows:

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

technical subject matter that has been invented; the term “invention” may be used to refer to subject matter which is nonobvious; and the term “invention” may be used to refer to subject matter defined by the claims of a patent application. Thus, the mere fact that the present patent application uses the term “invention” in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the patent application using the sentence “As used herein, the term ‘_____’ is hereby defined to mean...” or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present patent application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word “means” and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the “broadest reasonable interpretation” of claims.

It is also respectfully submitted that the claims are supported by the application, that the claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added. In this regard, it is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“[T]he claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement.”). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

C. REJECTIONS RAISED IN APRIL 23 OFFICE ACTION

In the April 23 Office Action, claims 1-37 were rejected for the following reasons. Claims 1-2, 13, 17-18 and 29 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,251,013 B1 to Bennett (hereinafter Bennett). Claims 3-7 and 19-23 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bennett in view of U.S. Patent No. 5,980,384 to Barrie (hereinafter Barrie). Claims 8-10 and 24-26 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bennett in view of U.S. Patent No. 6,089,977 to Bennett. Claims 11-12, 27-28, and 33-35 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bennett in view of U.S. Patent No. 6,409,602 B1 to Wiltshire (hereinafter Wiltshire). Claims 14-16 and 30-32 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Bennett in view of U.S. Patent No. 6,241,607 B1 to Payne et al. Claims 36-37 were rejected 35 U.S.C. § 103(a) as allegedly unpatentable over Bennett in view of Wiltshire and further in view of U.S. Patent No. 4,636,951 to Harlick.

By canceling claims 1-37, the rejections are moot. However, applicants have the following comments regarding claims 38-64, Bennett and Barrie.

D. INDEPENDENT CLAIM 38 AND ITS DEPENDENT CLAIMS ARE ALLOWABLE

Claim 38 recites a gaming apparatus including, among other things, a controller being programmed to generate a first video image representing a slot game and including a first arrangement comprising a plurality of symbols, to allow a user to select a first symbol from any of the plurality of symbols and a second symbol from any of the plurality of symbols, to allow the user to interchange the position of the first symbol with the position of the second symbol to define a second arrangement of the plurality of symbols, and to determine a value payout associated with the second arrangement. Thus, the gaming apparatus recited in claim 38 allows the user to select and interchange any of the plurality of symbols from the first arrangement with any other of the plurality of symbols from the first arrangement.

On the other hand, Bennett states that gaming machine has "game control means ... being arranged to play a game, ... the game being characterized in that ... a game feature is invoked wherein a sprite randomly designates one or more of the symbols displayed on a display means to be treated as special symbols for that particular game and a prize is awarded for winning combinations formed with one or more of the special symbols." Col. 1: 55-67. It

is further stated that "pairs of symbols are randomly selected to be special symbols and the symbols in each pair are swapped with each other." Col. 2: 24-26. See also Col. 5: 25-33. This is not the claimed gaming apparatus, for in the claimed gaming apparatus, the user selects which symbols to interchange. Moreover, there is no teaching, motivation or suggestion in Bennett to give the user control of the selection. Consequently, Bennett alone does not anticipate or render unpatentable the gaming apparatus claimed in claim 38.

Likewise Barrie alone does not anticipate or render unpatentable the claimed gaming apparatus. Barrie states that "special 'Flip-Flop' symbols that may appear in [a] primary game may cause transposition of game symbols that appear in [a] secondary game." Col. 2: 27-30. Moreover, "[a] player may make the decision to permit symbol transpositions ..." Col. 2: 30-31. However, this too is not the claimed gaming apparatus, because the claimed gaming apparatus permits the user to select symbols from any of the plurality of symbols and to interchange the selected symbols.

Furthermore, there is no teaching, motivation or suggestion to modify the Bennett gaming apparatus or the Barrie gaming apparatus in light of the other to allow a user to select a first symbol and a second symbol from any of the plurality of symbols and to interchange the position of the first symbol with the position of the second symbol to get a second arrangement of the plurality of symbols. It is well settled that in order to establish a *prima facie* case of obviousness, there must be actual evidence of a suggestion to modify a prior art reference or to combine two prior art references, and the suggestion to combine or modify the prior art must be clear and particular. See, for example, *In re Dembicza*k, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Applicants submit that not only is such a suggestion missing, applicants note that both Bennett and Barrie are consistent in teaching that it is the gaming apparatus, not the user, that selects the first and the second symbol. Thus even if the references were combined, the modified gaming apparatus would not have each and every element of the claimed gaming apparatus.

Therefore, Bennett and Barrie, whether taken individually or in combination, do not anticipate or render unpatentable the claimed gaming apparatus of the independent claim 38. Moreover, claims 39-52 are also patentable over Bennett and Barrie, as being dependent upon the independent claim 38.

E. INDEPENDENT CLAIM 53 AND ITS DEPENDENT CLAIMS ARE ALLOWABLE

Claim 53 recites a gaming method including, among other things, allowing a user to make a wager, causing a first video image to be generated, the first video image representing a slot game and including a first arrangement comprising a plurality of symbols, allowing the user to select a first symbol from any of the plurality of symbols and a second symbol from any of the plurality of symbols, allowing the user to interchange the position of the first symbol with the position of the second symbol to define a second arrangement of the plurality of symbols, and determining a value payout associated with an outcome of said slot game based on the second arrangement. Given the similarities in the claim language of claim 38 and claim 53, claim 53 is allowable over Bennett and Barrie for much the same reasons and arguments advanced above. Moreover, claims 54-65 are also patentable over Bennett and Barrie, as being dependent upon the independent claim 53.

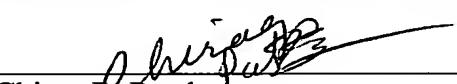
CONCLUSION

In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance. If there is any matter that the examiner would like to discuss, he is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,
MARSHALL, GERSTEIN & BORUN

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By:


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